

Office Action Summary

Application No.

10/749,762

Applicant(s)

ETLING, KEITH A.

Examiner

Alison K. Pickard

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 9-14, 25, 26 and 29-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-14, 25, 26, 31-33 and 35-37 is/are rejected.
- 7) ☒ Claim(s) 29, 30 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The allowability of several of the claims has been withdrawn after reconsideration of Middione, Kramer '250, and Nicholas '713. The examiner regrets any inconvenience.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 9, 11, 13, 31, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Middione (6,082,240).

Middione discloses a method and apparatus comprising a sealing member 23 and two surfaces (of 48 or 38 for example). The surfaces define a receiving aperture as seen best in Figure 2. The sealing member includes an attachment portion (e.g. part of 42) fixed to either surface and a seal portion. The seal portion has a deformable segment (e.g. near 43) facing the surfaces. The deformable segment is inserted into the aperture. The sealing member defines an opening (near line 27). A fastener 29 is aligned with the opening and underlies a portion of the sealing member. The fastener can be accessed from the opening. And, when the fastener is loosened, the deformable segment will be disengaged from the aperture (this will ultimately result in all the components being separated and thus the seal as a whole will become disengaged from between the two elements).

3. Claims 2 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nicholas (5,365,713).

Nicholas discloses a method and apparatus comprising a sealing member (e.g. 31) having an attachment portion (near 34) and a deformable segment 32 disposed in receiving aperture defined by the surfaces of 10 and 11. A coating (e.g. 15) is disposed continuously across the sealing member and the two surfaces (onto 19 and 20) so that none of the member is exposed. The coating defines a splice (at 40/41) that is considered coincident with a distal end portion of the sealing member.

Or, Nicholas discloses that the sizes and shapes sections of 15 can be adjusted and aligned as desired (e.g. col. 3, lines 18-31, 52-57). The dimensions are not limited to what is shown in the figures. And, it is not considered inventive to discover the optimum or workable ranges by routine experimentation absent some showing of criticality. See *In re Aller*, 105 USPQ 233, 235 (CCPA 1955). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the splice so that it aligns with an edge of the seal (note that "end" does not imply edge).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Middione in view of Pritchard (2,710,113).

Pritchard teaches coating over a seal and surfaces to further ensure a leak proof seal. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the seal of Middione with a coating to ensure a fluid tight seal for the apparatus.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Middione.

Middione does not disclose the deformable segment is elastomer sponge material. The selection of a known material based on its suitability for its intended use is considered obvious. See *In re Leshin*, 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the deformable segment by making it of elastomer sponge.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Middione.

Middione discloses a fastener 26 through the attachment portion of the seal. Middione does not appear to disclose that the fastener is a rivet. The examiner takes Official Notice that a rivet is a known fastener and is equivalent to a screw or bolt as shown in Middione. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a rivet as the fastener.

8. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Middione in view of Corsover (4,533,278).

Middione does not appear to disclose a release material. Corsover teaches a sealing element in an aperture defined between two surfaces. Corsover teaches the use of a release material 64 on a portion of the sealing element to prevent it from sticking to other components. It would have been obvious to one of ordinary skill in the art at the time the invention was made

to use a release material on the seal to prevent it from sticking to other elements. The use of a known technique to improve a similar device yields expected results.

9. Claims 1, 3, 5, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Middione in view of Corsover in view of Pritchard.

Middione discloses a method and apparatus comprising a sealing member 23 and two surfaces (of 48 or 38 for example). The surfaces define a receiving aperture as seen best in Figure 2. The sealing member includes an attachment portion (e.g. part of 42) fixed to either surface and a seal portion. The seal portion has a deformable segment (e.g. near 43) facing the surfaces. The deformable segment is inserted into the aperture. The sealing member defines an opening (near line 27). A fastener 29 is aligned with the opening and underlies a portion of the sealing member. The fastener can be accessed from the opening. And, when the fastener is loosened, the deformable segment will be disengaged from the aperture (this will ultimately result in all the components being separated and thus the seal as a whole will become disengaged from between the two elements).

Middione does not appear to disclose a filler. Corsover teaches a sealing element in an aperture defined between two surfaces. Corsover teaches the use of a release material 64 on a portion of the sealing element to prevent it from sticking to other components. The material can be considered a “filler” and could be applied to any surface of the apparatus to prevent sticking. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a release material on the seal to prevent it from sticking to other elements. The use of a known technique to improve a similar device yields expected results.

Pritchard teaches coating over a seal and surfaces to further ensure a leak proof seal. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the seal of Middione with a coating to ensure a fluid tight seal for the apparatus.

Regarding claim 37, Middione does not disclose the deformable segment is elastomer sponge material. The selection of a known material based on its suitability for its intended use is considered obvious. See *In re Leshin*, 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the deformable segment by making it of elastomer sponge.

10. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer (5,197,250).

Kramer discloses a method of sealing two surfaces 18 and 20 with a sealing member 38 having an attachment portion (at 36) and deformable segment 40. A release material 52 can be applied to the sealing member and would extend on the edges of 36 that face surfaces 30 and 28. The seal can then be positioned within the aperture. While Kramer does not specifically disclose this order, this method is considered obvious to one of ordinary skill in the art at the time the invention was made because this method would yield expected results and would at least be obvious to try. The element is capable of being installed in the aperture with the tape 52 already applied and would still be secured in the manner expected. The aperture is then filled with a filler (e.g. 66), which is between portions 28 or 30 of the surfaces and the deformable section. Coating 44 is applied continuously to the sealing member and portions 24 and 26 of the surfaces.

Allowable Subject Matter

11. Claims 29, 30, and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

12. During update of the search, the examiner realized that some of the cited prior art discloses some of the pending claims. The examiner regrets the inconvenience and has tried to provide the most thorough consideration and rejection with respect to all cited prior art and the pending claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 571-272-7062. The examiner can normally be reached on M-F (9-5).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer Gay can be reached on 571-272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alison K. Pickard/
Primary Examiner, Art Unit 3676

AP